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PATENT
Attorney Docket No.: 11823-002630US

Examiner J. Reeves, Ph.D.
Art Unit: 1642
U.S. Patent and Trademark Office
Washington, DC 20231

On February 17, 2000

By: _____

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CARY L. QUEEN ET AL.

Application No.: 08/484,537

Filed: June 7, 1995

For: IMPROVED HUMANIZED
IMMUNOGLOBULINS

Examiner: J. Reeves, Ph.D.

Art Unit: 1642

**RESPONSE TO ADVISORY ACTION
AND REQUEST FOR
RECONSIDERATION UNDER
37 CFR §1.129(a)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Advisory Action mailed February 3, 2000, applicants elect to proceed under the Transitional After Final Rule 37 CFR §1.129(a), and MPEP § 706.07(g). A Petition for Removal of Finality Under 37 CFR § 1.129(a) (authorizing the Commissioner to deduct the appropriate fee under 37 CFR § 1.17(r)) are submitted herewith. Applicants request that each of following earlier submitted documents be reconsidered and entered: the Amendment Under 37 CFR §1.116, the Supplemental Oath or Declaration Under 37 CFR §1.67, the Petition to Correct Inventorship Under 37 CFR §1.48, and the Substitute Specification Under 37 CFR §1.125, which were filed in the U.S. Patent and Trademark Office on December 23, 1999, in addition to the Statement that the Substitute Specification contained no new matter and the marked-up copy of the Substitute Specification, as required under 37

*Received
2-17-00*

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CFR §1.125 filed with the U.S. Patent and Trademark Office on January 18, 2000.

The Advisory Action indicated that a marked-up copy of the Substitute Specification and the accompanying statement regarding new matter were not on file. We have confirmed that these papers were hand-delivered to the U.S. Patent and Trademark Office on January 18, 2000, and accordingly, we believe that they are now in the Examiner's file.

The Advisory Action indicates that the Supplemental Declarations filed on December 23, 1999 were defective. Applicants believe that said Declarations were filed in accordance with 37 CFR 1.67, 37 CFR 1.63, and MPEP § 603, and that perhaps confusion occurred because the Examiner did not have all the submitted papers. However, if the Examiner now maintains the position that the Supplemental Declarations were defective, Applicants respectfully request that such defects be specified with greater particularity in order for Applicants to make the necessary corrections.

Apparently, the Examiner was of the view that Applicants inconsistently stated the relation between the subject application and its immediate parent case, U.S.S.N. 07/634,278. Specifically, the Advisory Action stated that Applicants had indicated that the subject application was a continuation-in-part application of the parent application, whereas the file wrapper recited that it was a continuation application, and that the Amendment filed on May 14, 1998 indicated that it was a divisional of the parent case. In response, Applicants respectfully submit that after reviewing the file, we cannot find an indication that the subject application is a continuation-in-part of the immediate parent application, U.S.S.N. 07/634,278. Applicants acknowledge the seemingly inconsistent recitations of a divisional application and a continuation application. Such inconsistency apparently arose from the fact that while the application as amended on May 14, 1998 might have been properly characterized as a divisional of the parent case, the subsequent extensive amendments to the claims and addition of new claims during prosecution of the subject application have rendered it a continuation application. For this reason, the Substitute Specification filed on December 23, 1999, which also incorporated all of the amendments made to the subject specification during prosecution, has correctly characterized the subject application as a continuation application of its immediate parent case.

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Applicants have attempted to promptly and fully address each of the issues raised in the Advisory Action with the above comments and explanations. Applicants believe that all formalities have been corrected and that claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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